

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
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Craig D. YARDLEY et al.) Group Art Unit: 3721
)
Application No.: 10/689,379) Examiner: Christopher R. HARMON
)
Filed: October 20,2003)
)
For: SINGLE-PLY DISPENSER NAPKIN) Confirmation No.: 3363

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VIA EFS-Web

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Further to the Notice of Appeal filed concurrently herewith, Applicant requests review, before the filing of an Appeal Brief, of the Final Office Action dated March 28, 2007, in the above-identified application. No amendments are being filed with this request. Review is requested for the reasons stated in the five-page attachment to this paper, entitled "Arguments for Consideration." The undersigned is an attorney of record.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 16, 2007

/Robert C. Stanley/
By: _____
Robert C. Stanley
Reg. No. 55,830

ARGUMENTS FOR CONSIDERATION

Claims 80-90 are pending in this application and stand rejected in the Final Office Action dated March 28, 2007 (“Final Office Action”). This application generally describes and claims methods of making a single-ply paper napkin product with no longitudinal folds and at least one transverse fold that runs perpendicular to the machine direction. The claims currently pending are those presented in the Response filed January 15, 2007. Claim 80 is representative of the claimed subject matter:

80. A method of making a paper napkin comprising:
- (a) providing a single-ply paper web having a machine direction and a cross machine direction, wherein a longitudinal dimension is in the machine direction and a transverse dimension is in the cross-machine direction, and wherein the longitudinal dimension is at least about two times the transverse dimension;
 - (b) optionally orienting the web for longitudinal folding in the machine direction; and
 - (c) folding one transverse free edge of the single-ply paper web toward the other transverse free edge to create two panels in the single-ply paper web;
- wherein the napkin contains no longitudinal fold and at least one transverse fold.

In the Final Office Action, the Office re-asserted the rejections presented in the non-final Office Action dated October 16, 2006. Applicant requests a pre-appeal brief review of those rejections and submits that this application is in condition for allowance.

The Term “At Least About” Is Not Indefinite

The Office has rejected claims 80-90 under 35 U.S.C. § 112, second paragraph, asserting that the term “at least about” is indefinite. See Final Office Action at 2. Applicant believes that the Office’s reliance on MPEP § 2173.05—and in particular on *Amgen, Inc. v. Chugai Pharm. Co. Ltd.*, 927 F.2d 1200, 18 U.S.P.Q. 1016 (Fed Cir. 1991) cited therein—is improper. In particular, as argued in Applicant’s Response dated January 15, 2007, *Amgen* is not inapplicable to this application. See Response at 5-7. In *Amgen*, the Federal Circuit found “about” to be indefinite because the method

for measuring the property at issue was itself “an imprecise form of measurement within a range of error.” *Amgen* at 1217. In contrast, the method for measuring the property at issue here—the ratio of two dimensions—is not inherently imprecise nor does it create any ambiguity. As noted in the prior Response, two other cases cited in MPEP § 2173.05, finding the term “about” to be definite, are more analogous to the facts here.

That the specification also uses the word “about” when disclosing possible values for the two individual dimensional lengths does not change the result. First, the pending claims do not recite “about” the dimension; the claims simply recite “a longitudinal dimension” and “a transverse dimension.” The skilled artisan would readily be able to determine the magnitude of those dimensions, e.g., by measuring the length of the napkin sides. The claims then merely recite that the “longitudinal dimension is at least about two times the transverse dimension.” Comparing the two measured dimension values, and determining whether the longitudinal value is at least about two times the transverse value, is easily within the abilities of the skilled artisan, such that the scope of the claims can be readily assessed. See MPEP § 2173.05. For example, Table 1 of the specification shows an exemplary napkin according to pending claims called “SuperServ” with a length (longitudinal dimension) of 17 inches, which is clearly “at least about two times” the width (transverse dimension) of 6.5 inches. There simply is no indefiniteness or ambiguity inherent in Applicant’s use of “about” in the pending claims.

Page 5 of the Final Office Action appears to also allege that the claims lack written description support or are not enabled, since twice the smallest exemplary transverse dimension mentioned in the specification (3 inches x 2 = 6 inches) may not equal “at least about” 9.5 inches, the smallest exemplary longitudinal dimension. That position is not proper at least because Applicant is not restricted to claim only examples from the specification, the dimensions are not quantified in the claims, and the recited ratio is separately and wholly supported and enabled by at least the second paragraph

on page 27 of the specification. Therefore, any rejection on that ground is also improper and Applicant requests that this rejection be withdrawn in its entirety.

“Machine Direction” and “Cross-Machine Direction” Should be Considered

The Office has refused to consider the recited terms “machine direction” or “cross-machine direction” in evaluation of the patentability of the pending claims. In particular, the Office believes that those terms have not been sufficiently defined in the claims. See Final Office Action at 5-6. However, the skilled artisan would immediately know that the machine direction refers to the transporting direction of the paper web as it is formed and travels on a paper-making machine (not the transport direction on the folding machine, as suggested by the Office), and the cross-machine direction is the transverse or 90° of the machine direction. Any paper that is formed on a paper-making machine inherently has a machine direction and cross-machine direction, regardless of whether or not it is subsequently folded, as is readily known to the skilled artisan.

That understanding can clearly be seen in the specification, for example, in the paragraph spanning pages 27 and 28, which states: “Depending on the orientation of the single-ply web upon cutting of the individual napkin substrates, the transverse fold can run parallel to either the machine direction or the cross-machine direction of the web.” That passage demonstrates that the web contains a machine direction and a cross-machine direction upon its formation, and that folding may then subsequently occur in either of those dimensions depending on how the web is oriented for folding.

The Office relies on the first paragraph on page 27—disclosing an exemplary napkin having a 1-to-1 ratio in tensile strengths—to assert that a web need not have a machine direction and a cross-machine direction. See Final Office Action at 6. However, equal tensile strength does not mean that a web lacks machine and cross-machine directions; the last paragraph of page 26 explicitly indicates that both directions still exist even if tensile strengths are equal. Machine direction and cross-machine

direction are inherent in paper webs and, therefore, those terms are sufficiently definite and must be considered in determining patentability of the pending claims.

No Claim is Anticipated by Lazar or Chan

The Office has rejected claims 80-81, 84, 86, and 90 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,256,334 to Lazar (“Lazar”) and claims 84-85 and 88 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,716,691 to Chan (“Chan”). With proper consideration of the terms “machine direction” and “cross-machine direction,” Applicant submits that the paper products disclosed in Lazar and Chan are different from the pending claims and that those references cannot serve to anticipate.

Lazar is not directed to a napkin, does not teach that “the longitudinal dimension is at least about two times the transverse dimension,” and shows only folds in the cross-machine direction and no transverse folds in the machine direction. As explained in Applicant’s Examiner’s Interview on July 11, 2006, the description on page 1, line 104 to page 2, line 2, would clearly indicate to the skilled artisan that Lazar’s folds are only in the cross-machine direction. Lazar clearly cannot anticipate the pending claims.

Chan fails to teach or suggest that “the longitudinal dimension is at least about two times the transverse dimension,” or that its folds are transverse folds in the machine direction with no longitudinal folds in the cross-machine direction. In fact, the particular folding structure of Chan requires at least one fold to be in the cross-machine direction, due to the overall folding structure required by the reference—thereby resulting in a longitudinal fold. Therefore, Chan also cannot anticipate the pending claims.

No Claim is Obvious Over the Prior Art

The Office rejected claims 84-85 and 88-89 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,469,243 to Ito et al. (“Ito”). However, as recognized by the Office, Ito does not disclose a single-ply paper product as recited by the instant claims, but instead a four-ply paper product. See col. 2, lines 62-66. Ito is also directed only to an industrial size shop wiper (see col. 1, lines 6-15) and further does not disclose a

longitudinal dimension of at least about two times the transverse dimension. Not only does Ito fail to teach or suggest each of the limitations of the pending claims, but, given the extreme differences between its wiper product and the recited napkins herein, the skilled artisan would have had no motivation to modify the Ito product from a 4-ply product to a 1-ply product, in addition to providing the dimensions recited by the pending claims. In short, Ito cannot support a proper *prima facie* case of obviousness.

The Office also rejected claims 82-83 and 87 under 35 U.S.C. § 103(a) as obvious over Lazar in view of the supposed Admitted Prior Art (“APA”). Although Applicant opposes the Office’s contention that Applicant has admitted the prior art asserted by the Office, that supposed APA does not remedy any of the defects of Lazar discussed above. In particular, the supposed APA does not teach at least a method of making a napkin with only folds in the cross-machine direction and no folds transverse folds in the machine direction, nor does the Office assert that it does. Therefore, even if the skilled artisan were motivated to make the proposed combination, the subject matter of the pending claims would not be achieved, revealing no *prima facie* obviousness.

Conclusion

If the Office agrees with any of Applicant’s positions asserted in this Request, prosecution should be reopened so that Applicant may respond to the Office’s remaining positions. Applicant’s arguments clearly show that “at least about” is not indefinite in the claims and that “machine direction” and “cross-machine direction” should be considered for purposes of patentability. Even if those arguments are not accepted, at least the anticipation rejections over Lazar and Chan should be withdrawn because those references do not teach or suggest transverse folds in the machine direction with no longitudinal folds in the cross-machine direction. However, Applicant respectfully submits that the arguments herein clearly reveal that all of the rejections should be withdrawn and the pending claims passed to allowance.